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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,679	07/11/2001	Eric Aubay	022701-939	8975

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EXAMINER

MRUK, BRIAN P

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 01/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,679

Applicant(s)

AUBAY ET AL.

Examiner

Brian P Mruk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 30 and 31 is/are rejected.
- 7) ☒ Claim(s) 5-29 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Oath/Declaration

3. The examiner notes that the Title of the Invention that appears in the oath is written in French. Appropriate correction is required.

Specification

4. The abstract of the disclosure is objected to because the abstract should be limited to a single paragraph. Correction is required. See MPEP § 608.01(b).

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5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

6. The use of the trademarks "Empicryl 6835", and "Bisomer S20W, S10W" (page 10, lines 7-27); "Sipomer BEM", "Sipomer SEM-25", and "Sipomer WAM II" (page 11, lines 1-12); "Empicryl 6835" (page 19, line 27); "Triton X-45, X-114, X-100 and X-102", "Tergitol 15-S-9", "Tergitol 24-L-6", "Neodol 45-9", "Neodol 23-65", "Neodol 45-7", "Neodol 45-4", "Kyro EOB", "Pluronic", and "Tetronic" (page 23, lines 6-23); "Sokalan CP5", "CMC blanose 7MXF", "Symperonic A3", and "Symperonic A9" (page 37, lines 12-26); "Repel-O-Tex PF 594" (page 38, line 13); and "Contrexeville" (page 39, line 8) have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

7. Claims 5-29 and 32 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may not depend from another multiple

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dependent claim. See MPEP § 608.01(n). Accordingly, claims 5-29 and 32 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 2-4 and 30-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. In the present instance, claim 2 recites the broad recitation "a mean particle size of polymer of from 10 to 500 nm", and the claim also recites "preferably from 20 to 300 nm, most particularly from 20 to 100 nm and even more particularly from 20 to 50 nm" which is the narrower statement of the range/limitation. This problem also occurs in lines 3-4 of claim 3. Appropriate correction is required.

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11. Claim 4 recites the limitation "said particles" in lines 10 and 13-14. There is insufficient antecedent basis for this limitation in the claim. Specifically, the examiner notes that the phrase "said particles" should be amended to recite "said nanoparticles" to provide proper antecedent basis. Appropriate correction and/or clarification is required.

12. Claim 30 provides for the use of a composition for treating fabrics in an aqueous or wet medium, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 30 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

For examination purposes, the examiner will treat instant claim 30 as a process for treating fabrics in an aqueous or wet medium comprising contacting the fabric with a fabric care agent composition comprising nanoparticles or at least one nanolatex of polymer (P) that is insoluble in the medium.

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13. Claim 31 recites the limitation "characterized in that the said nanoparticles or the said nanolatex protect fabrics against physical **or** chemical degradation **and/or** provide softening **and/or** crease-resistance properties." The "and/or" phrases in instant claim 31 render the claim vague and indefinite, since it is unclear which properties need to be imparted to the fabric. Appropriate correction is required.

14. Claim 31 provides for the use of a composition for treating fabrics in an aqueous or wet medium, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 31 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

For examination purposes, the examiner will treat instant claim 31 as a process for treating fabrics in an aqueous or wet medium comprising contacting the fabric with a fabric care agent composition comprising nanoparticles or at least one nanolatex of polymer (P) that is insoluble in the medium, wherein the fabric care agent composition imparts at least one property selected from the group consisting of physical degradation

protection of the fabric, chemical degradation protection of the fabric, softening of the fabric, crease-resistance of the fabric, and mixtures thereof.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1-4 and 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Sharma et al, WO 98/00449.

Sharma et al, WO 98/00449, discloses a waterborne polymer composition having an average particle size of less than 70 nm and a solids content of about 10 to about 45 weight percent, which provides yarn abrasion resistance, blocking, water resistance, wet fastness/bleeding, and dry and wet crock resistance to fibrous articles, per the requirements of instant claims 1-4 and 30-31 (see page 3, lines 20-27 of Sharma et al). It is further taught by Sharma et al that the waterborne polymer composition contains one or more monoethylenically unsaturated monomers, such as styrene, methacrylate and methylmethacrylate monomers (i.e. water insoluble monomers), per the requirements of instant claim 1 (see page 5, lines 4-16 of Sharma et al). Specifically, note page 10, waterborne polymer compositions A-E, which disclose water insoluble polymers having particle sizes between 54-60 nm and a solids content of 30-35%, and

Examples 3-7, which discloses fabric treatment compositions comprising aqueous solutions/dispersions of waterborne polymer compositions A-E, which are applied to fabrics to impart sizing and abrasion resistance, per the requirements of instant claims 1-4 and 30-31. Therefore, instant claims 1-4 and 30-31 are anticipated by Sharma et al, WO 98/00449.

17. Claims 1, 2, 4 and 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsuda et al, U.S. Patent No. 4,746,455.

Matsuda et al, U.S. Patent No. 4,746,455, discloses a liquid composition for clothing articles comprising 0.01-10% by weight of an organic polymer in the form of a polymer latex, having an average particle size of 0.005 to 0.2 microns (i.e. 5-200 nm), per the requirements of instant claims 1, 2, 4 and 30 (see col. 1, lines 37-45 of Matsuda et al). It is further taught by Matsuda et al that the polymer latex is prepared by polymerizing water insoluble monomers, such as styrene, butylacrylate and diethylaminoethylmethacrylate monomers, in the state of a microemulsion, per the requirements of instant claims 1 and 4 (see col. 1, lines 64-67 and col. 2, line 20-col. 3, line 28 of Matsuda et al). Specifically, note Table 1, Latex D, which is an n-butylacrylate/diethylaminoethylmethacrylate polymer with a particle size of 0.04 micrometers (i.e. 40 nm), and Example 3, Table 8, which discloses an aqueous solution of Latex D that is applied to fabrics to prevent felt shrinkage, per the requirements of instant claims 1, 2, 4 and 30-31. Therefore, instant claims 1, 2, 4 and 30-31 are anticipated by Matsuda et al, U.S. Patent No. 4,746,455.

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18. The examiner notes that the references cited in the International Search Report as "X" references are cumulative to the art rejections of record, and thus, have not been applied in this Office action in accordance with **MPEP 706.02**.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (703) 305-0728. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (Before Final) and (703) 872-9311 (After Final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

BPM

Brian Mruk
January 9, 2003

Brian P. Mruk
BRIAN P. MRUK
PATENT EXAMINER
TECH CENTER 1700